

Appl. No.: 09/827,504
Amdt. Dated: 06/08/2006
Off. Act. Dated: 03/09/2006

REMARKS/ARGUMENTS

Reconsideration of this application is respectfully requested in view of the foregoing amendments and discussion presented herein.

1. Rejection of Claims 1-19, 21-23, 25 and 26-31 under 35 U.S.C. §112, first paragraph.

Claims 1-19, 21-23, 25 and 26-31 were rejected under 35 U.S.C. §112, first paragraph as being indefinite.

This rejection is based on the Examiner's assertion that the specification does not comply with the written description requirement with respect to certain elements of various claims. However, there are several particularly noteworthy problems with the Examiner's position in this regard. First, the Examiner does not provide any discussion that explains why the Examiner does not believe that the specification supports the particular claim elements noted by the Examiner. Secondly, and quite significantly, the specification does in fact expressly support the majority of the claim elements objected to by the Examiner - the support is clearly spelled out. Thirdly, those elements which are not literally supported (e.g., the specification does not repeat the claim language) are within the knowledge of one of ordinary skill in the art regarding this area of technology, and specifically data marking devices. One of ordinary skill in this area will appreciate these inherent elements, and it was neither necessary, nor desirable, to describe what would have been known to one of ordinary skill in the art. Referring to MPEP 2164.01,

A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984). (**emphasis added**).

Appl. No.: 09/827,504
Amdt. Dated: 06/08/2006
Off. Act. Dated: 03/09/2006

To emphasize that certain aspects recited in the claims would have been understood by one of ordinary skill in the art without having to detail the same in the specification, the Applicant has included an article describing the Sony e-marker device from the Comdex show in the Fall of 2000. This article makes it clear that this form of data mark was known. This patent application builds on this body of e-marking patents from the assignee, Sony.

In the following section, the Applicant will address specific issues raised by the Examiner.

Claim 1. The Examiner contends that the specification does not support the phrase "*an input unit for inputting data marks wherein each said data mark indicates a time and represents content that is broadcast at said time*". However, the Examiner has not indicated what portion of this language is objectionable. The concept described in that phrase is not only well known to those in the industry, but is described in the specification at, for example, page 1, lines 19-24; page 2, lines 18-22; page 4, lines 22-26, and so forth. The specification also includes reference to application no. 09/401,103 filed in September 1999, as being incorporated therein and providing additional detailed information.

Claim 11. The Examiner objects to original Claim 11, which recites "*music file includes a text and an image information corresponding to said music file*". However, this feature is described in the specification at page 10, lines 15-16 as well as in other portions of the specification. As an original claim, this language is thus part of the original specification. The Applicant calls to the attention of the Examiner MPEP 2163 section I:

See *In re Koller*, 613 F.2d 819, 204 USPQ 702 (CCPA 1980) (original claims constitute their own description); accord *In re Gardner*, 475 F.2d 1389, 177 USPQ 396 (CCPA 1973); accord *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). **It is now well accepted that a satisfactory description may be in the claims or any other portion of the originally filed specification.** (emphasis added)

Appl. No.: 09/827,504
Amdt. Dated: 06/08/2006
Off. Act. Dated: 03/09/2006

Claim 13. The Examiner objects to original Claim 13, which recites "*input unit includes a music broadcast mark button and television broadcast mark button*". However, this feature is described in the specification at page 11, lines 23-26 and elsewhere. In addition, as an original claim, this language is thus part of the original specification.

Claim 16. The Examiner objects to original Claim 16, which recites "*wherein said external device includes one or more of a personal computer, a personal digital assistant, a television set, a mobile telephone, a pager, and a wireless communication device*". Again this is both described in the specification, such as at page 11, lines 22-30, and the original claims which form a part of the specification as originally filed.

Claim 19. The Examiner objects to original Claim 19, and in particular "*a title of the album corresponding to each music marks, and graphical display of an album cover corresponding to each music marks*". Again these aspects are both described in the specification, such as at page 12, lines 4-8, and found in this claim which formed a part of the original specification.

Claim 21. The Examiner objects to original Claim 19, and in particular the phrase "*determining that maximum number of data marks have been received; and outputting an output signal responsive to said determining step*". Again these aspects are both described in the specification, such as at page 9, line 20 through page 10, line 5, and found in this claim which formed a part of the original specification.

Claim 25. The Examiner objects to original Claim 25, in particular the phrase "*said data marks include one or more of a time stamp information and a data stamp information*". These aspects are known with regard to e-marker devices and found in this claim which formed a part of the original specification.

Claim 26. The Examiner objects to Claim 26. The portion objected to was found in Claim 26 as originally filed. These aspects are found in the specification, such as at page 2, lines 15-23, and found in this claim which formed a part of the original specification.

Appl. No.: 09/827,504
Amdt. Dated: 06/08/2006
Off. Act. Dated: 03/09/2006

Claim 27. The Examiner objects to original Claim 27, and in particular the phrase "*detecting a disconnection from said gateway device; and resetting said stored data marks*". Again these aspects are both described in the specification, such as at page and found in this claim which formed a part of the original specification.

Claim 31. The Examiner objects to Claim 31, and in particular the phrase "*said received data includes one or more of text data, still image data, animated image data, and video data corresponding to said stored data mark*". Again these aspects are both described in the specification, such as at page 6 lines 3-20, and found in this claim which formed a part of the original specification.

Therefore, all of the elements of the claims which the Examiner asserts are not supported by the specification, are in fact supported by the specification and the knowledge of one of ordinary skill in the art. Accordingly, the rejection under §112, first paragraph should be withdrawn.

2. Objection to the Drawings.

The Examiner objected to the drawings for the stated reason that the drawings do not reflect the claim elements.

The Applicant traverses this rejection for several reasons. First, the Examiner has failed to point out specific elements which are missing, and only quotes the portions of the claims listed similar to the above, each of which recites lengthy claim portions. Secondly, a number of elements discussed in the claims are known to one of ordinary skill in the art with regard to e-marker devices and as such are inherent and preferably not shown in the drawings. The Applicant calls to the attention of the Examiner that<

A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984). (emphasis added)

In further response, the Applicant is willing to amend the drawings to include any specific elements that the Examiner can demonstrate are not specifically shown in the

Appl. No.: 09/827,504
Amdt. Dated: 06/08/2006
Off. Act. Dated: 03/09/2006

drawings and are beyond the knowledge of one of ordinary skill in the art.

3. Rejection of Claims 1-4, 7-8, 20 and 32 under 35 U.S.C. § 102(b).

Claims 1-4, 7-8, 20 and 32 were rejected under 35 U.S.C. § 102(b) as being anticipated by Bedard (U.S. Pat. No. 5,805,235).

The entirety of the support given by the Examiner for this rejection consists of :
"see, *figs. 1 3-6*".

Bedard reference describes program and channel selections that allows for quick recall of the channel. Refer to col. 1, lines 18-20 and 56-64; col. 2, line 64 through col. 3, line 2; col. 3, line 63 through col. 4, line 9; col. 4, lines 36-41 and so forth. Nothing in Bedard is even directed at a data marking device. Bedard provides no support for a number of elements of these claims, such as regarding Claim 1: "*each said data mark indicates a time and each said data mark represents content that is broadcasted at said time*". As the reference provides no such support it does not anticipate these claims.

To support an anticipation rejection, every claim element must be taught or inherent in a single prior art reference, Manual of Patent Examining Procedure (MPEP) §706.02a. A case has not been made to support anticipation.

Applicant respectfully asserts that the presently claimed invention is patently distinct from the cited reference, and the Applicant therefore requests that the present rejection of the above claims, and the claims that depend therefrom, be withdrawn.

4. Rejection of Claims 1-8, 20, 22, 25 and 32 under 35 U.S.C. § 102(b).

Claims 1-8, 20, 22, 25 and 32 were rejected under 35 U.S.C. § 102(b) as being anticipated by Sullivan (U.S. Pat. No. 6,906,733).

The entirety of the support given by the Examiner for this rejection consists of:
"see, *figs. 2,3-6*".

Sullivan is similar to the Bedard reference in that it also describes a TV program guide (listing). Extending beyond Bedard the user can have week-at-a-glance aspects arranged by network as outlined by the title and found in the specification. Refer to the abstract "electronic program guide", col. 1, lines 11-14; col. 2, lines 13-15; col. 2, lines

Appl. No.: 09/827,504
Amdt. Dated: 06/08/2006
Off. Act. Dated: 03/09/2006

21-23; and so forth. Nothing in Sullivan is even directed at a data marking device as that term is used in the instant application. Again the reference does not describe a data marking device as that term is known, while no teaching of data marks is being input to mark a time and represent content which has been broadcast.

To support an anticipation rejection, every claim element must be taught or inherent in a single prior art reference, Manual of Patent Examining Procedure (MPEP) §706.02a. A case has not been made to support anticipation.

Applicant respectfully asserts that the presently claimed invention is patently distinct from the cited reference, and the Applicant therefore requests that the present rejection of the above claims, and the claims that depend therefrom, be withdrawn.

5. Rejection of Claims 1-11, 14, 20, 22, 25 and 32 under 35 U.S.C. § 102(b).

Claims 1-8, 20, 22, 25 and 32 were rejected under 35 U.S.C. § 102(b) as being anticipated by Yoshinobu (U.S. Pat. No. 5,686,954).

The entirety of the support given by the Examiner for this rejection consists of: "see, *figs. 10, 15, 17, 18*".

Yoshinobu is also drawn to a program guide, but appears to describe how categorization information is sent and used for classifying the shows in the guide. Refer to the field of invention "kinds of programs to be broadcast"; col. 2, lines 40-46; and so forth. Nothing in Yoshinobu is even directed at a data marking device as that term is used in the instant application.

To support an anticipation rejection, every claim element must be taught or inherent in a single prior art reference, Manual of Patent Examining Procedure (MPEP) §706.02a. A case has not been made to support anticipation.

Applicant respectfully asserts that the presently claimed invention is patently distinct from the cited reference, and the Applicant therefore requests that the present rejection of the above claims, and the claims that depend therefrom, be withdrawn.

6. Rejection of Claim 26 under 35 U.S.C. § 103(a).

Claim 26 is rejected under 35 U.S.C. § 103(a) as being unpatentable over

Appl. No.: 09/827,504
Amdt. Dated: 06/08/2006
Off. Act. Dated: 03/09/2006

Hamada et al. (U.S. Pat. No. 6,931,198).

It should be appreciated that the Hamada reference and the instant application were both subject to assignment to Sony Corporation at the time of invention. However, Applicant contends that it still does not read on Claim 26.

In support of the rejection the Examiner contends that Independent Claim 26 describes all the claimed portions of the data marking device, and that connection to a gateway device would be obvious. To support this contention text portions from Hamada are referred to, but without comments as to how these supposedly relate.

On analyzing the portions of text recited in Hamada, it is seen that these portions do not comport to aspects of a data marking device. It appears that these sections were put forth on the basis of similar language, and not based on the underlying structure and inter-relation of elements found in Claim 26. For example, col. 2 lines 11-16 is put forth in support of "*transmitting stored data marks*", yet this section of Hamada describes a download process which has nothing to do with data marks: "*The receiving apparatus which the user owns is connected to a storage device used for downloading. As the storage device, an MD recorder, a VCR, or a DVD recorder can be used...*". Also used in support is col. 3, lines 11-23, which also describes the a collaborative download process for the recording system described.

This rejection ignores claim elements such as that "*said stored data mark indicates a time and said stored data mark represents content that is broadcasted at said time*". Support for an obviousness rejection requires that each element of the claim be properly considered, and that the cited reference be considered in its entirety.

Intractable shortcomings arise with the rejection as it does not disclose every claimed aspect, while Hamada is drawn to different inventive objects and uses different operating principles.

7. Rejection of Claim 1-20, 24-25 and 32 under 35 U.S.C. § 103(a).

Claim 26 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Marks et al. (U.S. Publ. No. 2002/0032019) in view of Yoshinobu et al. (U.S. Pat. No.

Appl. No.: 09/827,504
Amdt. Dated: 06/08/2006
Off. Act. Dated: 03/09/2006

5,686,954).

The Marks reference is not prior art, as it was filed after the instant application.

The Yoshinobu reference, as discussed previously, is directed to a program guide mechanism that allows communicating categorization information, and not to a system that provides data marking wherein data marks are created based on bookmarks which represent content broadcast at a given time.

Therefore, the rejection of the above claims is not proper. Applicant respectfully requests that the rejection of these claims, and the claims that depend therefrom, be withdrawn.

8. Claims 1-32 are nonobvious.

Nor would the subject matter of Claims 1-32 be obvious to a person having ordinary skill in the art in view of Bedard, Sullivan, Yoshinobu, and Hamada singly or in combination. None of these reference cited by the Examiner are directed to a device for performing data marking wherein the data marks indicate time and represent content that is broadcast. These cited references are not directed to similar objects or operating principles. Nor does the combination of references suggest, teach or provide motivation for the data marking aspects recited in the claims.

9. Amendments Made Without Prejudice or Estoppel.

Applicant has made amendments to a number of the claims to increase clarity of description. These amendments were not necessitated by the current rejections. These amendments have been made without any prejudice, waiver, or estoppel, and without forfeiture or dedication to the public.

10. Amendment of Claims 1, 12, 15, 20, 26, and 32.

Claim 1. Independent Claim 1 is drawn to an electronic data marking device and has been amended to improve clarity with regard to "*data marking*".

The use of a "*mark button*" is described to "*bookmark broadcast material in response to interaction by a user*". Support for which is found in the specification, such as on page 1, lines 19-28.

Appl. No.: 09/827,504
Amdt. Dated: 06/08/2006
Off. Act. Dated: 03/09/2006

Support for "*connecting through an internet connection*" is found throughout the specification, including page 2, lines 18-23; page 5, line 29 through page 6, line 6.

Support for "*retrieve text and/or image data*" is found in original Claim 31, as well as in the specification, such as at page 10, lines 5-15, and elsewhere.

Claim 12. Dependent Claim 12 has been amended to recite the user account aspect of data marking prior to retrieval of the text and/or image data associated with the data marks. Support for this aspect is found throughout the specification, such as at page 4, lines 12-18; page 8, lines 23-26; and elsewhere.

Claim 15. Dependent Claim 15 was amended to correct a minor typographical error, specifically the insertion of a comma, detected during the preparation of this response.

Claim 20. Independent Claim 20 is drawn to a method and describes bookmarking the time of a broadcast and display of information about the bookmarked item.

A term was added to describe how the data marks arise, specifically from "*bookmarking the time of a broadcast within a data mark stored within a plurality of data marks*".

The "*stored*" term of Claim 20 was already used in original Claim 26.

Support for bookmarking the time of a broadcast within a data mark is found in the specification on page 1, lines 21-22; page 10, lines 15-16; and page 2, lines 19-22.

Support for establishing connectivity with a gateway device and transmitting data marks thereto was described in original Claim 26 and elsewhere.

Support for the receipt and displaying of "*text and/or image data*" was already described previously.

Claim 26. Independent Claim 26 is drawn to a method, and is similar to Claim 20 above.

An element describing the bookmarking is introduced similarly to Claim 20.

Appl. No.: 09/827,504
Amdt. Dated: 06/08/2006
Off. Act. Dated: 03/09/2006

This independent claim includes "*entering user account information*" which was described with regard to amended Claim 12.

Claim 32. Independent Claim 32 has been amended to describe the bookmarking, and internet connectivity as in Claims 20 and 26 above.

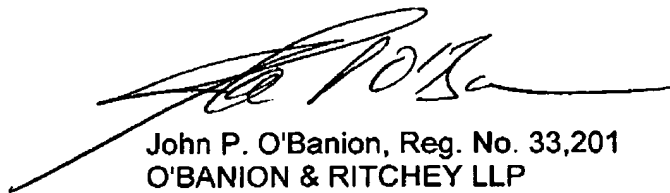
11. Conclusion.

Based on the foregoing, Applicant respectfully requests that the various grounds for rejection in the Office Action be reconsidered and withdrawn with respect to the presently amended form of the claims, and that a Notice of Allowance be issued for the present application to pass to issuance.

In the event any further matters remain at issue with respect to the present application, Applicant respectfully requests that the Examiner please contact the undersigned below at the telephone number indicated in order to discuss such matter prior to the next action on the merits of this application.

Date: 6/8/06

Respectfully submitted,



John P. O'Banion, Reg. No. 33,201
O'BANION & RITCHEY LLP
400 Capitol Mall, Suite 1550
Sacramento, CA 95814
(916) 498-1010

Attachment:

Article: "Sony Marker: How a Clever System Works" Fall Comdex 2000 (4 pages)

Dan Bricklin's Web Site: www.bricklin.com

[Home](#)

[Writings](#)

Sony eMarker: How a Clever System Works

An example of a system that puts the appropriate intelligence at the right places, and uses the Internet in ways that show the future.

[< The Value of Bandwidth](#) [The Software Police vs. the CD Lawyers >](#)

While walking through Fall Comdex 2000, I came across a product in the Sony booth that impressed me with the examples it presented about constructing a system.

The product is the Sony eMarker. To quote from the back of the package:

What is eMarker? eMarker is a service that allows you to bookmark songs off of your favorite radio stations... When you hear a song on the radio that you like, just push the button on the eMarker. Later, when you want to find out what song you heard and liked, plug the eMarker in to your PC. Our website will tell you what you heard... [Then you can buy a copy if you wish...]

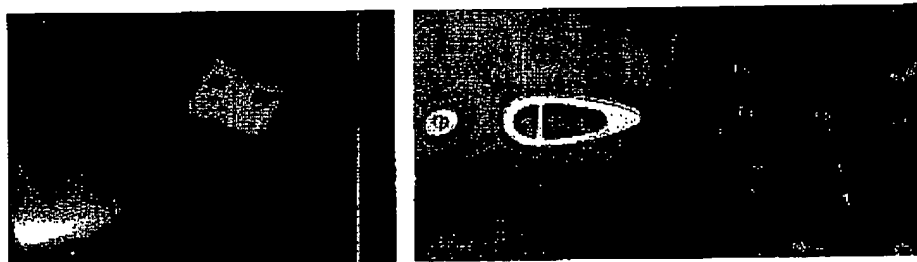
- eMarker package

The device sells for \$19.95. Here is a picture of it:



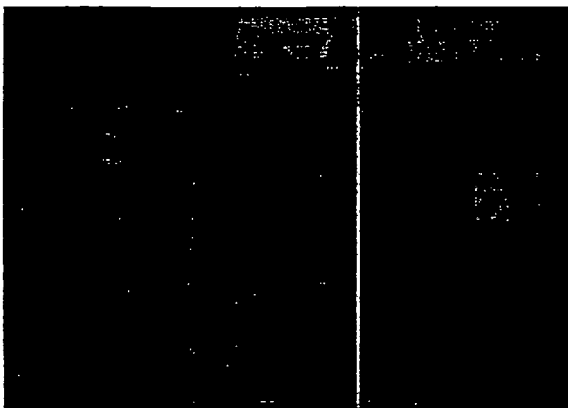
The eMarker, front and back

You can see the LCD display with dots representing each "eMark". You may create up to 10 eMarks before it's full. At any point you can connect the device to a Windows 98 PC. The end of the device pulls off to reveal a USB connector. You can plug it directly into a PC or a cradle that acts as a USB extension cord (it comes with the cradle). Here it is plugged into a laptop's USB port:



End of eMarker removed, plugged into USB port

Assuming you have installed the required USB driver and are connected to the Internet, your PC is automatically taken to the eMarker.com web site and a Flash application is launched. Your latest eMarks are uploaded to your "account" and displayed:



eMarker software running on PC

Here is a close-up. On the way to work, while listening to the car radio, I pressed the eMark button three times. Twice around the same time while listening to two different radio stations, and once a little later while listening to the first. After bringing up the list on the screen, I changed the default radio station for the middle song from 98.5 to 107.9 to get the correct song:

NEW eMARKS					
With Arms Wide Open		wed 11:22	98.5		
Creed		9:10:18 am	buy		
Last Kiss		wed 11:22	107.9		
Pearl Jam		9:08:36 am	buy		
Run-Around		wed 11:22	98.5		
Blues Traveler		9:05:11 am	buy		

Three eMarks on the screen

For each song there is (often) a button to press to read more about the artist/album that was the source of the song, as well as a button to press to play a 30 second clip from the song. You can also press buttons to see the song played before or after the selected song on that station, as well as change the station you are checking, or buy the CD. The service is free.

The company that developed this, [eMarker.com LLC](http://www.emarker.com), is a wholly owned subsidiary of Sony based in San Francisco. It was founded by Yuichiro "Woody" Deguchi, a long-time Sony executive. Prior to Sony, he worked at Osaka Japan's largest FM radio station, where he was in charge of translating the music news into Japanese from English.

How does it work?

When you first tell somebody about this system, they seem to always guess that the device is very "smart" and somehow detects which song is being played by "listening" to it. That would be quite expensive and difficult to do: lots of processor power, great microphones (and how do you deal with people who listen on earphones?), and more. You couldn't do that for \$19.95 today. So, how is it done?

The key to all this, of course, is the time. When you press the eMark button on the handheld device it records the time. When you upload the eMarks, the system can determine the actual time you pressed it (using deltas), as well as your ID (each device seems to have an ID). When

you sign up (it's free -- they just need a "name", "email address", and zip code) you specify which station to use as your default, as well as some alternates. I chose 98.5 for this example.

eMarker just compares the time it computes for when you pressed the button with information it knows about what was playing on your station at that time, a relatively simple procedure.

There is a separate service, Broadcast Data Systems (BDS), that provides the playlists (time and song) for over 1,100 radio stations (mainly popular music). BDS gets their information by having computers around the country that "listen" to a number of radio stations. Using a proprietary algorithm, they create "signatures" for songs as they are played, and compare them to songs in their database. This happens relatively quickly -- the eMarker web site can find songs only 10 minutes after they've been played on the air. For some stations, they can take 24 hours while they use other means to get the playlists. 98.5 is one of the "good" stations, which is why I used it. Many stations in Boston are "good". You can learn more about BDS from their [web site](#), especially the "[All About BDS](#)" page.

So, here's a diagram of how this system was constructed:

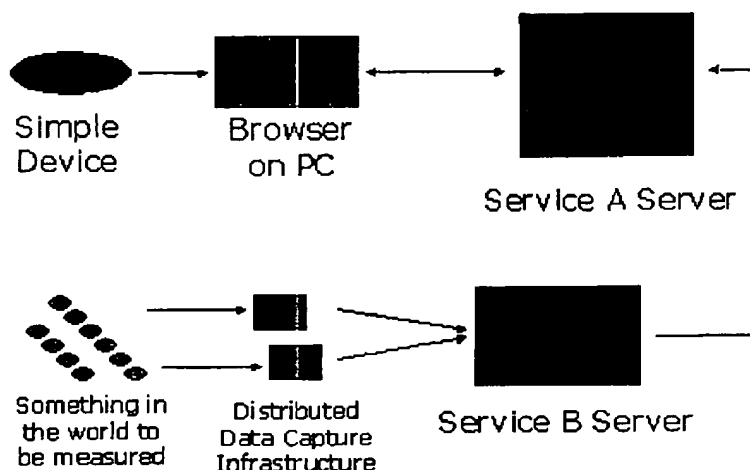


Diagram of eMarker system

What do we learn?

A thing to learn from this is how they gathered the most basic and minimal amount of information from the user and used another service that was specifically constructed to capture the other data needed. That service is actually used for a variety of other purposes that, in themselves, pay for its deployment. The eMarker server takes your personal information and merges it with the information from the other service, and presents it in a format most useful to you. (Actually, there are yet other services integrated here at the server level, such as linking you to the music clips -- [DiscoverMusic.com](#) -- and external eCommerce sites -- including [Amazon.com](#) and [CDnow.com](#).)

In addition to doing the right thing at the right place in the system, we also see that you need to know how to break a problem down into its component parts, and solve each problem in the appropriate way.

I like how such an extensive system seems to be built of very simple parts. It uses the computer-to-computer connectivity of the Internet in several ways and between different types of specialized devices. Special hardware (an "appliance") was created, but very simple, inexpensive, and appropriately sized to the task (it's on a key chain to keep with you). The "intelligence" for recognizing the songs is kept in controlled machines that can be easily upgraded, and the user interface is server-controlled so it can be improved over time. A great example of the next generation of applications.

September 2001:

In May, they added Mac support. On August 20, 2001, Sony sent an email to registered eMarker users announcing the upgraded eMarker 2.0 web site (It removed the Flash and added new features). On September 4th, they sent an email announcing that they will discontinue the service at the end of September 2001 (see the [CNet story](#)).

[Writings](#) [Home](#) < [Previous](#) [Next](#) >
© Copyright 1999-2006 by Daniel Bricklin
All Rights Reserved.

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record.**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☐ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☒ **OTHER:** _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.